

224



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,495	06/07/2000	Akihito Mochizuki	1232-4423US1	9609

7590 01/28/2004

Morgan & Finnegan LLP  
345 Park Avenue  
New York, NY 10154

EXAMINER
----------

BAROT, BHARAT

ART UNIT	PAPER NUMBER
----------	--------------

2151

DATE MAILED: 01/28/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/588,495

Applicant(s)

MOCHIZUKI, AKIHITO

Examiner

Bharat N Barot

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-12 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-12 and 15-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**RESPONSE TO AMENDMENT**

1. Claims 8-12 and 15-22 remain for further examination.

**The new grounds of rejection**

2. Applicants' amendments and arguments with respect to claims 8-12 and 15-20 and new claims 21-22 filed on November 10, 2003 (Paper Number 07) have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

**Specification**

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
4. The abstract of the disclosure is objected to because the provided abstract does not contain the proper language and format for an abstract of the disclosure.  
  
Appropriate correction is required. See MPEP § 608.01(b).
5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

Art Unit: 2155

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### **Claim Objection**

6. Claim 22 is objected to because of the following informalities: Claim 22 line 1 "said storage unit" should be --a storage unit--. Appropriate correction is required.

### **Claim Rejections - 35 USC § 102**

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 8-12, 15-17, and 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Linden et al (U.S. Patent No. 6,360,254). Linden's patent meets all the limitations for claims 8-12, 15-17, and 20-22 recited in the claimed invention.

9. As to claim 8, Linden et al disclose a data communication apparatus (figures 1-2; and column 5 line 59 to column 7 line 10) comprising: a first transmission unit (application server), arranged to transmit a URL representing the existence of additional information to a transmission destination (user) (figure 2; and column 7 lines 11-29); a reception unit (Web server/application server), arranged to receive a reply from the transmission destination for the URL transmitted by the first transmission unit (figure 2; and column 7 lines 30-51); a generating unit (Web server), arranged to generate a Web page including the additional information to be accessed based on the URL; and second transmission unit (Web server), arranged to transmit the Web page including the additional information based on the reply received by the reception unit (figure 2; and column 7 line 52 to column 8 line 4).

10. As to claims 9-10, Linden et al disclose that the second transmission unit transmits the additional information in a manner different from that of the first transmission unit and to a terminal (Web browser) different from a terminal (email application) to which the data was transmitted by the first transmission unit (figure 2; and column 7 lines 11-62).

11. As to claim 11, Linden et al disclose a link to a location of the additional information is set in the URL transmitted by the first transmission unit (figure 2; and column 7 lines 11-29).

12. As to claim 12, Linden et al disclose a processed content based on the reply received by the reception unit is further transmitted to the transmission destination (figure 2; and column 7 lines 52-62).

13. As to claims 15-16, they are also rejected for the same reasons set forth to rejecting claim 8 above, since claim 15 is merely a method of operation and claim 16 is merely a computer readable medium for the apparatus defined in the apparatus claim 8.

14. As to claim 17, Linden et al teach a data communication method comprising the steps of: recognizing a received email; displaying an image for display on the basis of a content recognized in the recognition step; and instructing a URL of the email recognized in the recognition step, to transmit a Web page including image data in a method other than the email so as to process the image displayed in the display step (figures 2, 3B, 4B, and 5-7; column 6 line 66 to column 8 line 4; column 8 line 54 to column 9 line 18; and column 9 line 53 to column 10 line 41).

15. As to claim 20, it is also rejected for the same reasons set forth to rejecting claim 17 above, since claim 20 is merely a computer readable medium for the method of operation defined in the method claim 17.

16. As to claims 21-22, Linden et al disclose an input unit arranged to input image data, wherein the additional information is the image data input by the input unit; and a storage unit stores the image data in a plurality of forms respective different image quality, wherein the second transmission unit transmits the image data each of the plurality of forms (figures 1-2 and 5-10; and column 5 line 59 to column 6 line 65).

**Claim Rejections - 35 USC § 103(a)**

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden et al (U.S. Patent No. 6,360,254) in view of Chang et al (U.S. Patent No. 6,134,584).

19. As to claims 18-19, Linden et al do not disclose that in the instruction step it is instructed to print the image and store the image data.

Chang et al explicitly disclose that in the instruction step it is instructed to print the image and store the image data (see abstract; column 4 line 50 to column 5 line 29; column 7 lines 34-65; and column 9 lines 51-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Chang et al in the data communication method of Linden et al because doing so would proved improved control on the data communication method for transmitting and receiving image data.

20. Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Additional Reference**

21. The examiner as of general interest cites the following reference.
- a Shane, U.S. Patent No. 5,793,972.



**Contact Information**

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bharat Barot whose telephone number is (703) 305-4092. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam, Hosain can be reached at (703) 308-6662. A central official fax number is (703) 872-9306.

Any inquiry of general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-3900.

Patent Examiner Bharat Barot

Art Unit 2155

January 13, 2004



**BHARAT BAROT  
PRIMARY EXAMINER**